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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,115	09/19/2003	Russell Norman Mirov	SUN03-0112	8531
22200	7590	12/27/2005	EXAMINER	
PARK, VAUGHAN & FLEMING LLP			DINH, TUAN T	
39180 LIBERTY STREET			ART UNIT	
SUITE 103			PAPER NUMBER	
FREMONT, CA 94538			2841	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/667,115	<b>Applicant(s)</b> MIROV, RUSSELL NORMAN	
	<b>Examiner</b> Tuan T. Dinh	<b>Art Unit</b> 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 8-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/20/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's election with traverse of Group I (claims 1-26, and Specie I (claims 1-7, and 17-26) in the reply filed on 10/07/05 is acknowledged. The traversal is on the ground(s) that:

(a) there is n distinct between Group I and II because in both claims 17 and 27 have been claimed "a detachable key", and (b) claim 17 is generic claim, and read on Species I-IV (figures 1-4), and Specie I is not distinct from Species II-IV.

This is not found persuasive because:

(a) the method does not require particular the limitation of "separation means for facilitating detachment of the mechanism and the circuit board" as require in claim 1, and even though, both claims 17 and 27 are claimed "detachment key" but they are applied on an assembly in different functions, for example, claim 17 is required "within the portion of the assembly, a signal conduit configured to carry a signal, and in claim 27 recited a signal conduit configured convey a signal between the key and the assembly. Therefore, claims 17 and 27 are distinct

(b) claim 17 is not generic claim. The limitation of "one or more... detached from the assembly" do not read on figure 1. As described in a specification as on page 3 line 25 through page 4, line 24, claim 17 does not read. Further, there are four distinct embodiments (I-IV) as described in the specification, see page 2, the searches for each features above would be non-extensive and thus, considered a burdensome search. Thus, Specie I is distinct from Species II-IV.

Since claim 17 does not read on Specie I (figure 1) elected by the applicant, therefore, claims 17-26 are withdrawn from further consideration as being drawn to non-elected subject matter.

Claim 6 recites "said identification means comprises a visible identification code" read on figure 2 (Specie II), and not read on figure 1. Thus, claim 6 is withdrawn from further consideration as being drawn to non-elected subject matter

The requirement is still deemed proper and is therefore made FINAL. Claims 6,8-33 are withdrawn from further consideration as being drawn to non-elected subject matter.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "**identification means for...comprises an identification circuit**" see claim 4 do not shown in figure 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "a processor or other IC, the key may include a barcode, hologram, an etched identification string, an electronic identification chip, a key identification maybe an encapsulated, etc. in figure 1, see page 4, lines 3-24 as described in the specification". Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, line 3, it is unclear. The phrase of "the mechanism further comprises identification means for identifying the mechanism" is not understood. As claimed in claims 1-3, the applicant recited the mechanism comprising "a wire trace and gaps" and further in claim 4 recited the mechanism further comprising identification means for identifying the mechanism (which are including the trace and gaps), so what does applicant mean of "identification means for" What does it cause to be identifying the mechanism (trace +gaps)?

By applying art, the examiner assumes that the "identification means" is a circuit.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Reece (U.S. Patent 6,783,926).

As to claims 1-3, Reece discloses a circuit board (22b) as shown in figures 2-14 comprising: a mechanism comprising:

signal means for (wire trace 26a) conducting a signal between the mechanism and the circuit board (22b); and

separation means (gaps 27) for facilitating detachment of the mechanism from the circuit board;

wherein the circuit board becomes at least partly non-functional if the mechanism is detached from the circuit board.

As to claims 4-5, and 7, Reece discloses the mechanism further comprises identification means for identifying the mechanism is an identification circuit (pads 32), and is protected from being easily manipulated.

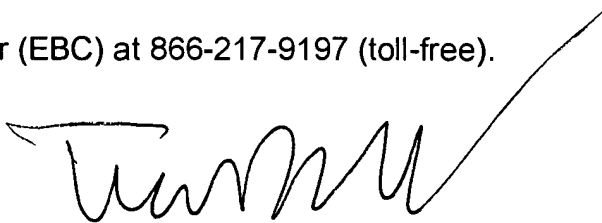
***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kadonaga discloses related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T. Dinh whose telephone number is 571-272-1929. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kammie Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Tuan Dinh', with a long, sweeping flourish extending upwards and to the right.

Tuan Dinh  
December 20, 2005.